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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/962,271 10/31/97 FREEMAN

G 04644/068001

EXAMINER

QM11/0819

FOSTER, J

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601 THIRTEENTH STREET N W  
WASHINGTON DC 20005

ART UNIT PAPER NUMBER

3728

DATE MAILED:

08/19/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. <b>08/962,271</b>	Applicant(s) <b>Freeman et al.</b>
	Examiner <b>J. Foster</b>	Group Art Unit <b>3728</b>

Responsive to communication(s) filed on \_\_\_\_\_.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-51 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) 1-12 is/are allowed.

Claim(s) 13, 15-17, and 19-51 is/are rejected.

Claim(s) 14 and 18 is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Applicant's **ASSENT OF ASSIGNEE AND OFFER TO SURRENDER** filed March 17, 1998 is acceptable.

2. Applicant's reissue declaration (paper 4) filed on March 17, 1998 is substantially acceptable. However, the heading for the declaration is inaccurate as stating that the declaration is pursuant to 35 U.S.C. 1.171. There is no such statute.

Applicant clearly appears to have been intending to refer to the regulation, 37 CFR 1.171. Accordingly, the examiner has amended the heading to refer to the regulation, and Applicant should correspondingly amend Applicant's own copy of this paper.

3. Claims 23-51 are objected to under 37 CFR 1.121(e) since, although they are new claims over the patent, they have not been underlined. Correction is required.

4. Claims 1-10 and 49 are allowable over the prior art of record. In the reference of Cartmell et al, an electrode is provided at conductor 34, and a package is provided by elements 70,12,22,60. The plate/sheet 22 is includes a release coating on its upper surface, and therefore clamp plate/sheet 60 is releasably adhesively attached thereto. However, the plate 60 is strongly attached by adhesive to frame 12. Therefore, the plate 60 cannot be fully released to permit the package to open into a generally flat configuration as set forth in the claims.

5. Claims 11 and 12 are also allowable over the prior art of record.

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6. Claims 23-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 20-22 are functional and indefinite because there is insufficient structure recited in the claims to perform the function, "for maintaining a first said electrode in either a sealed mode ... or an unsealed mode." The term "compartment" is insufficient to support this function since compartments are not required to be openable and closable without further description. Claim 38 has a similar problem with the function, "may be exposed to the external environment by opening the envelope."

Claim 23 is functional and indefinite because there is insufficient structure recited in the claim to perform the function, "for maintaining the electrode in isolation." Claim 26 has a similar problem.

Claim 23 is also functional and indefinite because there is insufficient structure recited in the claim to perform the functions, "is removable from the compartment to expose the electrode" and "maintains the electrical connection to the electrode when the electrode is removed from the compartment."

Claim 42 is functional and indefinite because there is insufficient structure recited, regarding the location and form of the strain relief elements in the claim, to perform the function, "for relieving strain on the lead wires."

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. Claims 13, 15, 16, 19, 23, 24 and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Engel (4,539,996). In the reference of Engel, an electrode is provided at 18, and a package is defined by the combination of backing 20, strip 24 and release liner 26. The release liner is releasably adhesively attached at least to the strip 24 (see Fig. 2). Connected to the electrode 18 is an electrically conductive path/connector 16. A portion of the element 16 located under the barrier element/strip 24 may be considered to be a connector body portion of the barrier element. In addition, the tip of connector 16 may be defined as being a terminal.

Regarding a second compartment, the area between the unnumbered tabs of the backing 20, which extend beyond the strip 24, may be considered to define a second compartment within which the terminal end of the connector 16 resides, insofar as Applicant has claimed.

9. Claims 23-28, 45, 48 and 51 are rejected under 35 USC 102(e) as being anticipated by Gilman et al (5,402,884). In the reference of Gilman et al, a package is provided at 99,100, and defibrillator electrodes are provided at 128,129. The periphery of the package provides a barrier element. Extending from within the compartment of the package through the periphery

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of the package to the exterior environment are connectors/connective paths/connector bodies 132,135. The portions of the connector bodies which extend through the package periphery/barrier element may be considered to be a part of the barrier element. The portions exterior to the periphery may be considered to define connectors or terminals. Inasmuch as the wire conductors and insulators of the connector bodies are round in cross section, they provide arcuate (i.e., semicircular) top and bottom portions of the connector body which are engaged by top (100) and bottom (99) walls of the package compartment.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 16, 17, 19, 43 and 44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gilman et al (5,402,884) in view of Engel (4,539,996). Although the reference of Gilman et al does not disclose how the electrode packages are opened, the reference of Engel (col. 5 lines 47-50) suggests that top and bottom walls of an electrode package may be releasably sealed in order to permit opening of the package. Accordingly, it would have been obvious in view of Engel to have made the sealed periphery of Gilman et al with a releasable seal, for the purpose of opening the package.

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Although the reference of Gilman et al does not disclose sealing the top and bottom walls of the package to the upper and lower surfaces of the connector bodies 132,135, the reference of Engel (col. 5, lines 38-46; Fig. 2) suggests adhesively attaching a connector body (16) to between upper and lower walls (24,20) in an electrode package. Such adhesive attachment would inherently complete the seal of the electrode within the package. Therefore, it would have been obvious in view of Engel at 24,25 to have provided a sealing attachment between the connectors 132,135 of Gilman et al and the top and bottom walls 100,99, for the purpose of completely sealing the package.

12. Claim 50 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Engel (4,539,996) in view of Gilman et al (5,402,884). Although the reference of Engel does not disclose a defibrillator electrode, the reference of Gilman et al suggest providing a package for a defibrillator electrode for storing it prior to use. Accordingly, it would have been obvious in view of Gilman et al to have packaged as the electrode 12,18 a defibrillator electrode, for the purpose of storing it prior to use.

13. Claims 14 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. Claims 20-22 are would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. § 112.

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15. Claims 29-42 and 47 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 and to include all of the limitations of the base claim and any intervening claims.

  
JIMMY G. FOSTER  
PRIMARY EXAMINER  
GROUP 3728 8/14/98

JGF/(703)308-1505  
August 14, 1998